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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,690	08/05/2002	Neil J. Rowley	PA-9948	3740

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EXAMINER

JONES, DAMERON LEVEST

ART UNIT	PAPER NUMBER
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1618

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/069,690	Applicant(s) ROWLEY ET AL.	
	Examiner D. L. Jones	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

ACKNOWLEDGMENTS

1. The Examiner acknowledges receipt of the acceptable RCE filed 3/24/06.

Note: Claims 1-9 are pending.

RESPONSE TO APPLICANT'S ARGUMENTS

2. The Applicant's arguments filed 3/24/06 to the rejection of claims 1-9 made by the Examiner under 35 USC 103 have been fully considered and deemed non-persuasive for reasons of record in the office action mailed 12/22/05.

I. The rejection of claims 1-4, 8, and 9 under 35 USC 103(a) as being unpatentable over Felder (US Patent No. 5,132,409) in view of either one of Schott Glaswerke (DE 29609958) or Walther (US Patent No. 6,200,658) is MAINTAINED for reasons of record in the office action mailed 12/22/05 and those set forth below.

II. The rejection of claims 1, 5, 6, 8, and 9 under 35 USC 103(a) as being unpatentable over Albert (US Patent No. 5,545,396) in view of either one of Schott Glaswerke (DE 29609958) or Walther (US Patent No. 6,200,658) is MAINTAINED for reasons of record in the office action mailed 12/22/05 and those set forth below.

III. The rejection of claims 1, 5, and 7-9 under 35 USC 103(a) as being unpatentable over Larsen (US Patent No. 6,466,814) in view of either one of Schott Glaswerke (DE 29609958) or Walther (US Patent No. 6,200,658) is MAINTAINED for reasons of record in the office action mailed 12/22/05 and those set forth below.

Applicant's assertions may be summarized as follows. (1) Felder does not disclose the specifics of the vial. (2) Schott Glaswerke does not disclose in detail what

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is in the vial, but uses generic terminology like 'pharmaceutical' or 'diagnostic agents' to describe the material in the vial. (3) Walther contains no detail to the diagnostic agents or contrast agents. (4) Felder does not elaborate on improving the vial or the importance of the vial, but seems satisfied with the vial as it is.

(Note that the Examiner will not duplicate each and every response to the assertions set forth in the response filed 9/26/05 which overlap with some of those set forth in the response filed 3/24/06. Instead, Applicant's attention is directed to the responses of record in the Examiner's Answer mailed 12/22/05. Applicant's current response has been reviewed and the rejections and Examiners response mailed 12/22/05 is still deemed proper).

Applicant is reminded that a reference is not limited to its preferred embodiment(s), but for what it teaches as a whole. Thus, a reference does not have to elaborate on why other components were not used in the vial so long as the prior art anticipates or renders obvious the components being claimed by Applicant. Also, it should be noted that the rejections are combination rejections, thus, attacking the references individual does not overcome the cited prior art rejections. In addition, it should be noted that the references each do not have to teach each and every limitation of the claims individually since the rejections are combination rejections. As a result, since one or more of the references teach a hyperpolarized material or a diagnostic agent having a non-radioactive metal complex, the rejection is deemed proper. While Applicant asserts that the cited prior art uses the generic terms 'diagnostic agent' and 'hyperpolarized', it is noted that Applicant also uses those generic terms. As previously

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state, the broad teaching of the diagnostic agent or pharmaceutical compositions is not viewed as being critical to the advantages of the silica coated vials.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617.

The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


D. L. Jones
Primary Examiner
Art Unit 1618

June 12, 2006